



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,089	09/22/2000	Reiko Habuto	450100-02728	9784

20999 7590 02/20/2003

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
----------	--------------

2182

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,089

Applicant(s)

HABUTO ET AL.

Examiner

Eron J Sorrell

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-83 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 8, 9, 17-20, 22-28, 31, 32, 40-43, 45-51, 54, 55, 63-66, and 68-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuba et al. (U.S. Patent No. 5,806,072 hereinafter referred to as Kuba).

4. Referring to apparatus claim 1, method claim 24, system claim 47 and program claim 70, Kuba discloses a reading-and-writing apparatus, system, and method for reading and writing data in at least one conforming format to a recording medium

Art Unit: 2182

capable of recording data in a plurality of formats, the reading and writing apparatus and system comprising:

reading-and-writing means for performing reading and writing to the recording medium (see item labeled 10 in figure 2);

control means for controlling the data reading-and-writing apparatus so as to record the data in the conforming format in a predetermined directory of the recording medium (see lines 53-67 of column 14 and lines 1-7 of column 15), to read the data in the conforming format from the predetermined directory of the recording medium (see lines 18-23 of column 15), and to recognize information concerning a non-conforming format, which differs from the conforming format, by referring to a directory other than the predetermined directory of the recording means (see lines 19-50 of column 28).

5. Referring to apparatus claim 2, method claim 25, system claim 48, and program claim 71, Kuba discloses the reading-and-writing apparatus informs a user of a state of the data reading-and-writing apparatus based on the information concerning the data in the non-conforming format (see lines 19-50 of column 28).

6. Referring to apparatus claim 3, method claim 26, system claim system claim 49, and program claim 72, Kuba discloses the reading-and-writing comprises a display means for performing predetermined display, under the control of the control means, based on information concerning the data in the non-conforming format (see lines 12-18 of column 28).

7. Referring to apparatus claim 4, method claim 27, and system claim 50, Kuba discloses a light-emitting means for emitting light, wherein the control means varies a light emitting state of the light-emitting means based on the information concerning the data in a non-conforming format (see lines 5-20 of column 27).

8. Referring to apparatus claim 5, method claim 28, and system claim 51, Kuba discloses using an audio alert means for generating an audio alert based on the information concerning the data in the non-conforming format (see lines 51-60 of column 49).

9. Referring to apparatus claim 8, method claim 31, and system claim 54, and program claim 75, Kuba discloses the reading-and-writing apparatus further comprises operating means for giving

Art Unit: 2182

instructions (see figure 3), wherein the control means causes the display means to perform predetermined display in accordance with the instructions given by the operating means (see items labeled 12c, and 12d in figure 8).

10. Referring to claim apparatus claim 9, method claim 32, and system claim 55, and program claim 76, Kuba discloses the control means in the reading-and-writing apparatus causes the display means to display in response to the instruction given by the operating means to determine the content of the recording medium (see lines 60-67 of column 18 and lines 1-13 of column 19), and in response to the instruction given by the operating means to read the recording medium (see figure 43).

11. Referring to claim apparatus claim 17, method claim 40, system claim 63, and program claim 81, Kuba discloses the data in the plurality of formats are stored in directories having corresponding predetermined names (see lines 22-45 of column 5); and

the control means refers to the directories based on the names of the directories (see lines 44-56 of column 1).

Art Unit: 2182

12. Referring to claims apparatus claims 18 and 19, method claims 41 and 42, and system claims 64 and 65, Kuba discloses the directories are created in the root directory, or in any other existing directory (see lines 53-67 of column 14 and lines 1-7 of column 15).

13. Referring to apparatus claim 20, method claim 43, system claim 66, and program claim 82, Kuba discloses the reading-and-writing apparatus comprises storage means for storing corresponding relationship information indicating the corresponding relationships between the names of the directories and the content of the data stored in the directories;

wherein the control means compares, based on the corresponding relationship information in the storage means, the names of the directories recorded on the recording medium with the names of the directories indicated in the corresponding relationship information (see lines 32-45 of column 34).

14. Referring to apparatus claim 22, method claim 45, and system claim 68, Kuba discloses the conforming format includes one type (see lines 30-51 of column 25).

Art Unit: 2182

15. Referring to apparatus claim 23, method claim 46, and system claim 69, Kuba discloses the recording medium includes a non-volatile memory (see lines 11-30 of column 14).

Claim Rejections - 35 USC § 103

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 2182

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 6,7,29,30,52,53,73, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuba.

19. Referring to claims apparatus claims 6 and 7, method claims 29 and 30, system claims 52 and 53, and program claims 73, and 74, Kuba fails to explicitly set for the limitation that the control means controls the display to display the number of non-conforming items and the size of the non-conforming items on the display.

Kuba does however disclose using a hierarchical directory structure similar to MS-DOS (see lines 23-28 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kuba such that the control means controls the display to display the number of non-conforming items and the size of the non-conforming items on the display. MS-DOS is capable of displaying the number predetermined files and the size of those files and Kuba suggests using a hierarchical directory structure such as MS-DOS.

Art Unit: 2182

20. Claims 21, 44, 67, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuba in view of Ando et al. (U.S. Patent No. 6,341,196 hereinafter referred to as Ando).

21. Referring to apparatus claim 21, method claim 44, system claim 67, and program claim 83, Kuba fails to disclose the directories storing data indicating the content of the data stored in the directory and the control means recognizing the content of the data stored in the directories based on the data indicating the content of the data.

Ando discloses a reading-and-writing apparatus wherein the directories store data indicating the content of the data stored in the directory and the control means recognizing the content of the data stored in the directories based on the data indicating the content of the data (see lines 1-15 of column 18).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kuba with that of Ando such that the directories store data indicating the content of the data stored in the directory and the control means recognizing the content of the data stored in the directories based on the data indicating the

Art Unit: 2182

content of the data. This would allow the contents of the directory to be inspected by just reading that data.

22. Claims 11-15, 34-38, 57-61, 78, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuba in view of Walters et al. (U.S. Patent No. 6,453,281).

23. Referring to apparatus claims 11-15, method claims 34-38, system claims 57-61, and program claims 78 and 79, Kuba discloses identifying non-conforming data (see lines 37-50 of column 8), however Kuba fails to explicitly set forth the limitations that the non-conforming data is erased and how it is erased.

Walters discloses a reading-and-writing apparatus wherein some or all of the data files can be erased from the system either in file units or category units and information concerning the files to be deleted are shown on the display (see lines 8-39 of column 21).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kuba such that some or all of the data files can be erased from the system either in file units or category units and information concerning the files to be deleted are shown on

Art Unit: 2182

the display. This would allow for capacity of the memory card used in another system to be completely used by the instant device.

24. Claims 16,39 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuba in view of Takayanagi (U.S. Patent No. 5,251,297).

25. Referring to apparatus claim 16, method claim 39, system claim 62, and program claim 80, Kuba discloses identifying non-conforming data (see lines 37-50 of column 8), however Kuba fails to explicitly set forth the limitation that the non-conforming data is erased when the residual capacity of the recording medium for writing conforming data is insufficient.

Takayanagi discloses a reading-and-writing apparatus wherein data can be erased from memory when the residual capacity becomes insufficient (see abstract).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kuba with that of Takayanagi such that data can be erased from memory when the residual capacity becomes insufficient. This would allow for capacity of the memory card

Art Unit: 2182

used in another system to be completely used by the instant device.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

The following U.S. Patents are cited to further show the state of the art as it pertains to reading-and-writing apparatuses:

U.S. Patent No. 5,982,981 to Satoh

U.S. Patent No. 5,699,549 to Cho

U.S. Patent No. 5,886,957 to Yokota et al.

U.S. Patent No. 6,192,191 to Suga et al.

U.S. Patent No. 6,446,263 to Suzuki


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 703 305-7800. The examiner can normally be reached on Monday-Friday 10:00AM - 6:30PM.

Art Unit: 2182

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery A Gaffin can be reached on 703 308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746-7239 for regular communications and 703 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

EJS
February 12, 2003


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100